APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,340	11/20/2001	Travis J. Parry	10012807-1	1358

7590 08/12/2005	EXAMINER
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ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO 90C (Rev 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/989,340	PARRY, TRAVIS J.
	Examiner	Art Unit	
	Andrew H. Lam	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-20* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-20* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date *11/20/01*.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10 and 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated

by Takaira et al (U.S. 6,750,982) hereinafter Takaira.

Regarding claim 1, Takaira discloses a method of distributing data from an e-mail

enabled printer (fig. 2, schematic of printer 2, which can send/receive email),

comprising: retrieving data from a memory of said e-mail enabled printer (col. 3, lines

24-25, data storing unit 14 for storing email addresses, which the user can retrieve by

using the operation panel unit 18); attaching said data to an e-mail (col. 3, lines 33-34,

attach printer driver to email message); sending said e-mail and attached data to an e-

mail enabled device (col. 3, lines 40-42, the email is send to the email server connected

to network N) ; and storing at least said attached data in a job retention memory of said

e-mail enabled device (col. 3, lines 40-42, the email is send to the email server

connected to network N--it is inherent that the server is a PC, which has memory to

retain the email body and attachment sent from the printer 2).

Regarding claim 2, Takaira discloses the method of claim 1, wherein said

retrieving data from a memory of said e-mail enabled printer comprises retrieving data

from a job retention memory of said e-mail enabled printer (col. 3, lines 30-34, the data

storing unit 14 store data for using the printer such as "method of setting the printer" and

"location of which the printer is placed" and printer driver all of which is send to the PCs

4 via network N, see fig. 1).

Regarding claim 3, Takaira discloses the method of claim 1, wherein said

retrieving data from a memory of said e-mail enabled printer is initiated using a device in

communication with said e-mail enabled printer (col. 3, lines 43-46, the operational

panel unit 18 is used to attach and send email).

Regarding claim 4, Takaira discloses the method of claim 3, wherein said device

in communication with said e-mail enabled printer includes a network device (fig. 1,

network N) selected from a group consisting of a workstation (fig. 1, workstations 4A,

4B, and 4C), an e-mail enabled printer (fig. 1, email enable printers 2A and 2B), and an

e-mail server (col. 3, lines 40-42, the email is send to the email server connected to

network N).

Regarding claim 5, Takaira discloses the method of claim 1, further comprising

creating an e-mail for attaching said data to (col. 3, lines 33-34, attach printer driver to

email message), said e-mail including an e-mail address (col. 4, lines 1-2, email

addresses are inputted via the operational panel unit 18).

Regarding claim 6, Takaira discloses the method of claim 5, wherein said

creating an e-mail for attaching said data to comprises: providing a list of available e-

mail addresses (col. 4, lines 12-13, the control unit 12 fetches the email addresses of

the PCs 4); selecting at least one of said available e-mail addresses (col. 4, lines 1-2,

email addresses are inputted via the operational panel unit 18); and creating an e-mail

addressed to each of said selected at least one available e-mail addresses (col. 4, lines

15-16, sends electronic mail based on the addresses).

Regarding claim 7, Takaira discloses the method of claim 6, wherein said

providing a list of available e-mail addresses comprises: retrieving a list of stored e-mail

addresses from a memory of said e-mail enabled printer (col. 4, lines 12-13, storing unit

14 stores the email addresses for the PCs 4); and displaying said list of stored e-mail

addresses for selection (col. 4, lines 1-2, email addresses are inputted via the

operational panel unit 18).

Regarding claim 8, Takaira discloses the method of claim 5, wherein said

creating an e-mail for attaching said data to comprises: retrieving at least one e-mail

address entered by a user; and creating an e-mail addressed to said at least one e-mail

address entered by said user (col. 4, lines 1-2, email addresses are inputted via the

operational panel unit 18--examiner is interpreting operational panel unit 18 as a GUI

where a user can retrieve email addresses from list or manually enter email addresses).

Regarding claim 9, Takaira discloses the method of claim 1, wherein said

attaching said data to an e-mail created by said e-mail enabled printer comprises

attaching said data to an e-mail addressed to at least one designated e-mail address

col. 4, lines 15-16, sends electronic mail based on the addresses).

Regarding claim 10, Takaira discloses the method of claim 1, wherein said

sending said e-mail and attached data to an e-mail enabled device comprises sending

an e-mail and attached data from said e-mail enabled printer to a network device (fig. 1,

network N) selected from the group consisting of a workstation (fig. 1, workstations 4A,

4B, and 4C), an e-mail enabled printer (fig. 1, email enable printers 2A and 2B), and an

e-mail server (col. 3, lines 40-42, the email is send to the email server connected to

network N).

Regarding claim 16, Takaira discloses a system (fig. 1, a system for connecting

printers with PCs) for distributing data, comprising: a network (fig. 1, network N); and at

least one e-mail enabled printer for communicating over said network (fig. 1, printers 2A

and 2B are email enable printers), said e-mail enabled printer comprising at least one

microprocessor for operating said e-mail enabled printer (fig. 2, control unit 12 control

the operation of the email enable printer for sending and receiving email); a display

panel for displaying data (fig. 2, operational unit 18), and a job retention memory for

storing data for distribution (fig. 2, user data storing unit for storing data).

Regarding claim 17, Takaira discloses the system of claim 16, wherein said e-

mail enabled printer further comprises a control panel for selecting data from data

displayed on said display device (fig. 2, operational unit 18, col. 4, line 1, operational

unit 18, is used for various data setting).

Regarding claim 18, Takaira discloses the system of claim 16, further

comprising, data stored in said job retention memory (fig. 2, user data storing unit 14,

col. 3, lines 30-34 stores files and printer driver).

Regarding claim 19, Takaira discloses the system of claim 16, wherein said e-

mail enabled printer further comprises at least one list of e-mail addresses for displaying

on said display device (col. 4, lines 12-13, the control unit 12 fetches the email

addresses of the PCs 4, which is then display to the user at operational panel unit 18).

Regarding claim 20, Takaira discloses the system of claim 16, further comprising:

an Internet connection for communicating with said network (fig. 1, network N, it is well

known in the art that an email servers has to use some type of protocol such as SMTP

which uses an Internet for sending and receiving email); an e-mail server for

communicating with said network (col. 3, lines 40-42, the email is send to the email

server connected to network N); and at least one workstation for communication with

said network (fig. 1, workstations 4A, 4B and 4C are connected via network N).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Takaira in view of Kageyama et al (U.S. 6,567,180) hereinafter Kageyama.

Regarding claim 11, Takaira discloses a method of distributing email comprising:

creating an e-mail (fig. 2, operational panel unit 18, is used to composed the email);

attaching said selected at least a file to said e-mail (col. 3, lines 33-34, attach printer

driver to email message); and sending said e-mail for distributing (col. 3, lines 40-42,

the email is send to the email server connected to network N).

Takaira does not disclose expressly that the attachment is a print job retained at

the printer.

Kageyama discloses that print job can be archive at the printer (see fig. 5, archive 2220).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Takaira as per teaching of Kageyama because by retaining print job in an archive at the printer it would have been simple to recall the document for re-print (col. 8, line 51) in such case that a print failure occurred.

Regarding claim 12, Takaira discloses the method of claim 11, wherein e-mail enabled printer can send attached file via email to another e-mail enabled printer (fig. 2, electronic mail sending/receiving unit 20).

Takaira does not disclose expressly that the attachment is a print job retained at the printer.

Kageyama discloses that print job can be archive at the printer (see fig. 5, archive 2220).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Takaira as per teaching of Kageyama because by retaining print job in an archive at the printer it would have been simple to recall the document for re-print (col. 8, line 51) in such case that a print failure occurred. Furthermore, by sending the print job via email from said printer A to printer B when printer A is out of ink printer B can process the job in order to save down time.

Regarding claim 13, Takaira discloses the method of claim 11, wherein said creating an e-mail comprises: retrieving a list of available e-mail addresses from said

memory of said e-mail enabled printer (col. 4, lines 12-13, the control unit 12 fetches the

email addresses of the PCs 4); selecting at least one e-mail address from said retrieved

list of available e-mail addresses (col. 4, lines 1-2, email addresses are inputted via the

operational panel unit 18); and addressing an e-mail with said selected at least one e-

mail address (col. 4, lines 15-16, sends electronic mail based on the addresses).

Regarding claim 14, Takaira discloses the method of claim 11, wherein said

creating an e-mail comprises: entering at least one e-mail address into said e-mail

enabled printer using a control panel of said e-mail enabled printer (col. 4, lines 1-2,

email addresses are inputted via the operational panel unit 18); and addressing an e-

mail with said at least one entered e-mail address (col. 4, lines 15-16, sends electronic

mail based on the addresses).

Regarding claim 15, Takaira discloses the method of claim 11, wherein said

selecting at least one of said files stored in said memory of said e-mail enabled printer

for distribution comprises: retrieving a list of files stored in said memory of said e-mail

enabled printer from said memory (fig. 2, user data storing unit 14, used to store files

and print driver); displaying said list of files stored in said memory; providing a control

panel for selecting at least one of said files and selecting at least one of said files using

said control panel (fig. 2, operation panel unit 18, allows user to select file and attach to

email).

Takaira does not disclose expressly that the attachment is a print job retained at

the printer.

Kageyama discloses that print job can be archive at the printer (see fig. 5,

archive 2220).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Takaira as per teaching of Kageyama because by retaining print job in an archive at the printer it would have been simple to recall the document for re-print (col. 8, line 51) in such case that a print failure occurred.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew H. Lam whose telephone number is (571) 272-8569. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
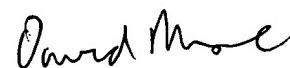
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